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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	91161969
Party	Plaintiff RITZ-CARLTON HOTEL COMPANY, LLC, THE
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)	
THE RITZ-CARLTON HOTEL)	
COMPANY, L.L.C.,)	
)	
Opposer,)	
)	
v.)	Opp. No. 91161969
)	
ROBERT B. WILCOX,)	
)	
Applicant.)	
)	

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I. INTRODUCTION

In his trial brief, Wilcox sidesteps the following key facts, which mandate a judgment for Ritz-Carlton: (1) the RITZ Marks owned by Ritz-Carlton are famous marks entitled to broad protection, sufficient to stop the registration of the confusingly similar mark RITZ for art gallery services; (2) Ritz-Carlton actually uses marks containing RITZ in connection with art gallery services, the sale of fine art, and various other art-related services, and had done so prior to the filing of Wilcox's application; and (3) the services Wilcox intends to offer travel in the same trade channels as those in which Ritz-Carlton uses its RITZ Marks and are targeted to the same consumers.

Because he cannot dispute these determinative issues, Wilcox instead bases his defense on arguments that are factually and legally erroneous. For example, Wilcox contends that only *three* of the fourteen registrations on which Ritz-Carlton is relying in this case are relevant and that Ritz-Carlton's rights are somehow limited to those registrations and the services listed therein. However, the evidence shows that Ritz-Carlton has enjoyed common law rights in marks containing RITZ for many years for art-related goods and services, in addition to the fourteen trademark registrations that are in the record for the RITZ Marks for a wide variety of goods and services. Additionally, Wilcox concedes that Ritz-Carlton's mark RITZ-CARLTON is famous only for hotel services. This is factually inaccurate and immaterial as a matter of law.

Because of the fame of the RITZ-CARLTON mark and the other RITZ Marks, Ritz-Carlton is entitled to broad protection of these marks on both related and unrelated goods and services. This admitted fact, by itself, should end this matter. There is more, however. Ritz-Carlton submitted substantial evidence of the wide variety of goods and services on which its RITZ Marks are used, including in connection with the advertising, promotion, and sale of a

number of art-related services, including the sale of fine art. Ritz-Carlton also submitted substantial evidence that (1) the services for which Wilcox is seeking registration are identical and closely related to those offered by Ritz-Carlton, (2) the services Ritz-Carlton offers and the services Wilcox intends to offer travel through the same channels of trade, and (3) the services are offered to the same or similar customers. None of this evidence has been refuted or contradicted by Wilcox.

For the reasons set forth herein and in Ritz-Carlton's Trial Brief, the Opposition Proceeding must be sustained.

II. EVIDENTIARY OBJECTIONS

Wilcox's Trial Brief is filled with improper references to alleged evidence that has not been made of record. Wilcox's Trial Brief does not include *even a single citation* to any part of the record, as required by Board rules. See TMBP 801.03 ("For each significant fact recited, the recitation of facts should include a citation to the portion of the evidentiary record where supporting evidence may be found."). "Factual statements made in a party's brief on the case can be given no consideration unless they are supported by evidence properly introduced at trial." See TBMP § 704.06(b); *see also Jansen Enterprises, Inc. v. Israel Rind and Stuart Stone*, 2007 WL 809857 at *6 (TTAB March 15, 2007) [hereinafter *Jansen Enterprises*]. Wilcox's belated references to matters not of record both is a calculated effort to create surprise and deprive Ritz-Carlton of the ability to offer rebuttal evidence, and it shows a willful disregard for the rules governing the introduction of evidence in Board proceedings. Wilcox's unsupported factual statements should be given no consideration.

A. WILCOX’S UNSUPPORTED ALLEGATIONS OF THIRD PARTY REGISTRATIONS SHOULD NOT BE CONSIDERED

Wilcox cites several alleged third-party registrations by specific registration number (*see* Wilcox Trial Brief at 14-15) and by vague and non-specific reference (*see* Wilcox Trial Brief at 4, 5, 15, 19). However, Wilcox has failed to make *any* third party registrations a part of the record by following any of the procedures prescribed by Board rules. Wilcox did not submit copies of any registrations with a notice of reliance, did not introduce copies of the registrations as an exhibit to testimony, and did not seek Ritz-Carlton’s stipulation to the introduction of any such evidence during his testimony period. *See* TBMP § 704.03(b)(1)(B).

Rather, Wilcox circumvented these rules and simply referred to registrations in his brief. Merely referencing registrations in a trial brief is not sufficient to make them of record. *See* TBMP § 704.03(b)(1)(B); *Jansen Enterprises*, 2007 WL at *6 (refusing to consider five registrations cited in brief to demonstrate alleged weakness of mark); *Crazy Shirts, Inc. v. J.B. Heise*, 2001 WL 901918, at *3 (TTAB Aug. 9, 2001) (refusing to consider registrations where applicant merely listed in its brief registrations that were not of record). The Board does not take judicial notice of registrations. *See* TBMP § 704.03(b)(1)(B). Therefore, all specific and non-specific references to third party registrations should not be considered.¹

¹ Even if the third party registrations Wilcox cites were permitted to form part of the record, such evidence is of little probative value in deciding likelihood of confusion because it does not prove that the marks are in use or that the public is familiar with them. *Jansen Enterprises*, 2007 WL at *6; TBMP 704.03(b)(1)(B); *see also* Lilly Pulitzer, Inc. v. Lilli Ann Corp., 376 F.2d 324, 325 (CCPA 1967) (“The existence of [third-party] registrations is not evidence of what happens in the market place or that customers are familiar with their use.”).

B. WILCOX’S UNSUPPORTED FACTUAL ALLEGATIONS OF THIRD PARTY USE AND CONSUMER PERCEPTION SHOULD NOT BE CONSIDERED

Wilcox also makes a number of sweeping claims as to alleged third-party use of “RITZ,” and speculative claims about consumer perception, all without any substantiation. *See, e.g.*, Wilcox Trial Brief at 4, 11, 12, 15, 19, 21. No testimony or other evidence corroborates any such alleged uses or consumer perception. Thus, these factual statements should be given no consideration. *See Jansen Enterprises*, 2007 WL at *6 (refusing to consider third party use evidence under identical circumstances). In *Jansen Enterprises*, the defendant in a cancellation proceeding claimed in its trial brief that the term “Izzy” was “‘a first name common to thousands of people,’ and that ‘hundreds, if not thousands of unregistered common law marks containing ‘IZZY,’ related to food or restaurants, exist nationwide.’” *Id.* The Board gave no consideration to these factual statements because there was neither testimony nor other evidence corroborating the claimed uses. *Id.* (citing TBMP § 704.06(b)).

As in *Jansen Enterprises*, Wilcox has presented no testimony or other evidence corroborating any of the alleged third-party uses of “RITZ.” There is no evidence to support Wilcox’s assertions that any of the alleged marks to which he cites are “widely advertised,” no evidence that the public associates RITZ with other parties, and no evidence that any goods are offered or sold in certain locations with or without RITZ on them. *See, e.g.*, Wilcox Trial Brief at 4, 11, 15. There is no way to know what effect, if any, these purported uses may have had in the minds of consumers. *See Jansen Enterprises*, 2007 WL at *6. Mere statements in a brief have no evidentiary value. Because Wilcox introduced no evidence during the testimony period to support his assertions of fact regarding third-party use of “RITZ” and consumer perception, the

Board cannot give consideration to Wilcox's statements on such issues. *See id.*; TBMP § 704.06(b).

C. WILCOX'S UNSUPPORTED CITATIONS TO DICTIONARY DEFINITIONS SHOULD NOT BE CONSIDERED

Wilcox also quotes alleged dictionary definitions that have not been made of record. *See* Wilcox Trial Brief at 11. There is no evidence of record to corroborate any such definitions. Wilcox did not put this evidence into the record by way of testimony or notice of reliance. Moreover, to allow such evidence to be introduced would unfairly deprive Ritz-Carlton of the ability to argue that other dictionaries contain no such definitions, or that "RITZ" is defined as a trademark owned by Ritz-Carlton. Thus, Wilcox's alleged dictionary evidence should not be considered. *See* TBMP § 704.06(b).

D. WILCOX'S ATTEMPTS TO BLAME RITZ-CARLTON FOR HIS EVIDENTIARY FAILURES ARE WITHOUT MERIT

To cover his errors, Wilcox accuses Ritz-Carlton of obfuscation and bad faith during the discovery period. These assertions, raised with the Board for the first time in Wilcox's Trial Brief, are spurious, unsupported, and untimely. Wilcox's failure to present evidence in this case was not due to any actions on the part of Ritz-Carlton or its counsel, who have followed the letter and spirit of the Board rules on discovery and testimony and fulfilled all obligations.² As the Board has stated, "[i]t [is] the applicant's sole responsibility to introduce the evidence on which it wished to rely during its trial period in accordance with the rules." *Edison Bros. Stores, Inc. v.*

² Wilcox's allegations to the contrary are baseless. Wilcox never served a single notice of deposition in this case, whether on Ritz-Carlton or its employees, executives, representatives, or agents. Wilcox never sought to depose either individual that Ritz-Carlton identified as having the best knowledge about the facts and issues in this case. Wilcox never filed any motion to compel discovery answers, to compel the production of documents, or to compel attendance at a deposition. Ritz-Carlton fully answered Wilcox's discovery requests, and every document Ritz-Carlton produced was responsive to document requests propounded by Wilcox.

Brutting E.B. Sport-International GmbH, 230 U.S.P.Q. 530, 531 n.8 (TTAB 1986). The Board should not be swayed by Wilcox's specious effort to blame Ritz-Carlton for his failure to properly introduce evidence in this proceeding.

III. ARGUMENT

A. THE OPPOSITION SHOULD BE SUSTAINED ON THE GROUNDS OF LIKELIHOOD OF CONFUSION

1. Likelihood Of Confusion Is Enhanced By The Fact That Ritz-Carlton's Registered RITZ Marks Are Strong, Famous, And Entitled To A Broad Scope Of Protection.

A finding of likelihood of confusion is inescapable when this issue is analyzed under the DuPont factors. *See In re E.I. DuPont DeNemours & Co.*, 177 U.S.P.Q. 563 (CCPA 1973). Because Wilcox could find no way to dispute the fame of Ritz-Carlton's RITZ Marks, Wilcox decided to argue that the only relevant registrations are the three registrations owned by Ritz-Carlton for the mark RITZ alone. *See* Wilcox Trial Brief at 4-7. In so doing, Wilcox blithely ignored Ritz-Carlton's well-documented common law rights and the eleven other registrations owned by Ritz-Carlton for marks containing RITZ that are part of this record.³ *See* Ritz-Carlton Trial Brief at 6-8; Notice of Reliance, Exs. 5-15. Wilcox's claim that Ritz-Carlton is entitled to rely only on three registrations is utterly unfounded. The fourteen registrations submitted by Ritz-Carlton demonstrate that Ritz-Carlton owns a family of marks containing or comprised of the word "RITZ" and that Ritz-Carlton owns registered rights in such marks for a wide variety of goods and services. *Id.*

Wilcox concedes that "the Ritz-Carlton marks are strong and may be famous." *See* Wilcox Trial Brief at 12. But, Wilcox attempts to qualify its concession by arguing these marks

are famous only “in the hotel field.” *Id.* Additionally, Wilcox argues that confusion is not likely “due to the fame of the Ritz-Carlton marks for hotel services.” *See* Wilcox Trial Brief at 16.

These statements reflect a misunderstanding of the law pertaining to this subject. Famous marks, like the RITZ Marks, are entitled to a broad scope of protection as a matter of law. *See Recot Inc. v. Becton*, 54 U.S.P.Q.2d 1894, 1894, 1897 (Fed.Cir.2000) (stating that “[f]amous marks thus enjoy a wide latitude of legal protection.”) [hereinafter *Recot*]; *Monster Cable Products, Inc. and Monster Cable International, Ltd. v. Tecmo, Ltd. and Tecmo Kabushiki Kaisha*, 2007 WL 411955, at *11 (TTAB Feb. 2, 2007) (recognizing that “famous marks enjoy a broad scope of protection or exclusivity of use”); *Hasbro, Inc. v. Lisa Pinkett*, 2004 WL 1427395, at *7 (TTAB June 18, 2004) (stating that “[t]he fame of a plaintiff’s mark, when fame is shown in the record, is never an unimportant factor, for a famous mark deserves a broad scope of protection.”); *McDonald’s Corp. v. McKinley*, 13 U.S.P.Q.2d 1895, at *6 (TTAB 1989) (stating that famous marks are entitled to greater protection because likelihood of confusion is enhanced with famous marks since “the more extensive the advertising and promotion of a mark, the more well known and likely to be recognized is that mark and the more likely it is that it will be confused with a similar mark used on similar or related goods.”).

Further, as a matter of law, “the broad scope of protection afforded to famous marks ‘applies with equal force when evaluating the likelihood of confusion between marks that are used with *goods that are not closely related.*’” *Recot, Inc. v. Becton*, 56 U.S.P.Q.2d 1859, 1861 (TTAB 2000) (quoting *Recot*, 54 U.S.P.Q.2d at 1897 (emphasis added)). To attempt to limit the fame of a mark impermissibly undermines the effect of owning a famous mark, which is, by

³ Wilcox inexplicably argues that the majority of registrations Ritz-Carlton relies upon “are accompanied by a Lion’s Head logo.” *See* Wilcox Trial Brief at 4. Only two of the fourteen registrations Ritz-Carlton submitted feature such a design element.

definition, protected against even non-identical marks and dissimilar products. Thus, as a matter of law, this factor weighs heavily in favor of a finding of likelihood of confusion.

Moreover, Wilcox ignores the overwhelming evidence of extensive use, advertising, and public awareness of the RITZ Marks for a wide variety of goods and services. The mark RITZ has been used by Ritz-Carlton as part of a family of marks containing or comprised of RITZ for over eighty years. *See* Gajcak Dep. at 11, 13; Flint Dep. Ex. 4; Notice of Reliance Exs. 5-15. Every year, tens of millions of dollars are spent advertising the RITZ Marks. *See* Gajcak Dep. at 41. The marks have been used extensively on a wide variety of goods and services, including art gallery services, retail store services, retail catalog services, timesharing services, fractional ownership services, real estate management and brokerage services, golf and spa services, educational services, and other goods and services. *See* Flint Dep. at 12-13, 19-20; Flint Dep. Ex. 1; Gajcak Dep. at 10-11. The RITZ Marks are displayed on a large number of advertising and promotional materials and various goods. *See* Ritz-Carlton Trial Brief at 4. These facts underscore the fame and renown of the RITZ Marks.

Furthermore, Wilcox does not attempt to rebut the evidence showing significant public exposure of the RITZ Marks that has resulted in an extraordinarily high degree of consumer awareness. *See* Gajcak Dep. at 30-35, Exs. 9, 10. Indeed, objective third party studies have shown that the overall RITZ-CARLTON brand is highly recognized and respected, that there is a high degree of consumer awareness, and that it is the most prestigious luxury brand in the United States. *Id.* Ritz-Carlton has submitted evidence that it has received numerous awards for the services offered under the RITZ Marks, and that Ritz-Carlton takes steps to police its marks and ensure they are used properly by those authorized to do so. *See* Ritz-Carlton Trial Brief at 9-10. None of this evidence has been rebutted by Wilcox. The fame and strength of Ritz-Carlton's

RITZ Marks entitle them to a broad scope of protection and weigh heavily in favor of a finding of likelihood of confusion.

Despite this overwhelming evidence, Wilcox asserts that RITZ “has acquired usage as a common noun by the general public” and “may very well be generic.”⁴ See Wilcox Trial Brief at 11. Wilcox also asserts that “Ritz-Carlton’s marks are no longer distinctive or arbitrary.” See Wilcox Trial Brief at 13. However, Wilcox’s assertions are mere attorney argument that is unsupported by the evidence and wholly without merit. See Evidentiary Objections Section II(B), II(C). There is no evidence of record that any party has used RITZ as a generic term for any goods or services in any manner.⁵ On the other hand, Ritz-Carlton submitted un rebutted documentary evidence and testimony that third parties routinely use RITZ alone to refer to Ritz-Carlton and its hotels. See Flint Dep. at 25; Gajcak Dep. at 13; Notice of Reliance Ex. 18.⁶ Moreover, Ritz-Carlton has submitted evidence of its use of RITZ alone to promote Ritz-Carlton’s services. See Gajcak Dep. at 13-26, Exs. 1-8; Flint Dep. at 23-24; Notice of Reliance Ex. 28. Wilcox has not asserted (and indeed cannot assert) that any of the evidence Ritz-Carlton has submitted to demonstrate use of the RITZ Marks, including RITZ alone, shows use of any of these marks in a generic manner. Contrary to Wilcox’s argument, the RITZ Marks are inherently strong because they are distinctive and arbitrary on the spectrum of distinctiveness as applied to the wide variety of goods and services on which Ritz-Carlton uses these marks.

⁴ This is a curious assertion from a party seeking registration of RITZ as a trademark.

⁵ Even if Wilcox had properly submitted the alleged dictionary definitions of “ritz” and “put on the ritz” (which he has not), such evidence is irrelevant. “The fact that a word or term may be found in a dictionary does not indicate that the word is lacking in trademark significance unless the dictionary meaning of the word is descriptive of the goods in connection with which it is used.” *Alberto-Culver Co. v. Helene Curtis Ind., Inc.*, 167 U.S.P.Q. 365, 370 (TTAB 1970). Because the mark RITZ has no descriptive significance in relation to the goods and services at issue, that mark is inherently strong.

⁶ This evidence also contradicts Wilcox’s assertion, again unsupported by any evidence, that “most consumers associate Ritz-Carlton and not Ritz” with the services provided by Ritz-Carlton. See Wilcox Trial Brief at 4.

Because the RITZ Marks are unquestionably distinctive, arbitrary, commercially strong, and famous, this factor weighs heavily in Ritz-Carlton's favor.

2. Confusion Is Likely Because The Parties' Marks Are Identical As To RITZ And Nearly Identical As To The Other RITZ Marks.

Despite asserting that the only relevant registrations at issue are those owned by Ritz-Carlton for RITZ alone, Wilcox later argues that the parties' marks are not identical. *See* Wilcox Trial Brief at 14. This is obviously untrue. There is no question that Ritz-Carlton uses and has registered the identical mark RITZ. When the marks at issue are compared, it is apparent that the likelihood of confusion is enhanced by the fact that Wilcox's mark RITZ is identical to Ritz-Carlton's mark RITZ. Moreover, Wilcox's mark is virtually identical and confusingly similar to the other RITZ Marks, including RITZ-CARLTON. This factor strongly favors Ritz-Carlton.

3. Confusion Is Likely Because The Parties' Goods And Services Are Closely Related.

Because the RITZ Marks are so famous, confusion would be likely even if Wilcox's services were not related.⁷ *NASDAQ Stock Market, Inc. v. Antarctica,, S.R.L.*, 69 U.S.P.Q.2d, 1718, 1734 (TTAB 2003) [hereinafter *NASDAQ*]. It is well established that goods or services need not be identical or even competitive to support a finding of likelihood of confusion. *Hilson Research, Inc. v. Society for Human Resource Management*, 27 U.S.P.Q.2d 1423, 1432 (TTAB 1993) [hereinafter *Hilson Research*]. It is sufficient instead that the services are related in some manner or that the conditions surrounding their marketing are such that they would likely be

⁷ Wilcox cryptically states that during discovery depositions, he "made it abundantly clear what his intentions for use of the mark were." *See* Wilcox Trial Brief at 9. Wilcox does not elaborate, and Ritz-Carlton is left wondering what point Wilcox is trying to make. What is clear is that the opposition proceeding must be decided on the basis of the identification of services listed in Wilcox's application, not on any statements Wilcox made in discovery depositions. *See Octocom Systems, Inc. v. Houston Computer Services, Inc.*, 16 U.S.P.Q.2d 1783, 1787 (Fed. Cir. 1990).

encountered by the same persons under circumstances that could give rise to the mistaken belief that they emanate from or are associated with the same source. *See id.*

Here, as demonstrated in Ritz-Carlton's Trial Brief, the parties' respective goods and services are very similar and closely related. Wilcox seeks registration for art gallery services, while Ritz-Carlton uses marks containing RITZ on and in connection with (1) the sale of fine art and other luxury goods (*see* Ritz-Carlton Trial Brief at 13-15); (2) offering space for artists and art galleries to sell or display art that is for sale (*see id.*); (3) hosting and sponsoring fine art auctions (*see id.* at 16-17); (4) hosting and sponsoring fine art exhibitions (*see id.*); (5) promoting the fine art collections in RITZ-CARLTON hotels as an inducement to customers (*see id.* at 17-19); (6) offering leisure packages featuring tours of fine art collections (*see id.* at 20); (7) disseminating art tour guide books (*see id.* at 19); (8) offering art classes (*see id.* at 20-21); (9) catering events at art galleries (*see id.* at 21); and (10) producing and distributing periodicals that feature articles about and advertisements for art and art galleries (*see id.* at 21-22). Ritz-Carlton's art-related activities are promoted and advertised through Ritz-Carlton's website, press releases, promotional materials, brochures, mail order catalogs, and other means. *See* Gajcak Dep. at 59-60.

Wilcox's characterization of Ritz-Carlton's use of the RITZ Marks on art-related services is misleading and often simply incorrect. For example, Wilcox claims that the retail shops located in RITZ-CARLTON hotels sell "common gift-type items," but not fine art. The record shows otherwise. Ritz-Carlton submitted testimony and evidence that these shops offer "inexpensive tasteful pieces up to very expensive pieces of art," including paintings and other artwork, art books, and high-end photography books. *See* Gajcak Dep. at 61; Flint Dep. at 28, 29, 81-83, Ex. 17; Ritz-Carlton Trial Brief at 13. Moreover, artwork displayed on the walls of

RITZ-CARLTON hotels is often offered for sale. *See* Flint Dep. at 26, 28, 34, 76-77, 124-125.

This includes art displayed in the hotel lounge, the hotel restaurant, guest rooms, and other locations.⁸ *See id.* RITZ-CARLTON hotels also display throughout the hotels artwork of artists and galleries that is available for purchase. *See* Flint Dep. at 26, 28-29, 97, Ex. 30. None of this evidence has been rebutted by Wilcox.⁹

Wilcox bases his argument that confusion is not likely on the grounds that Ritz-Carlton does not (1) operate an art gallery (2) in a “gallery setting” (3) that is branded as a RITZ gallery (4) that is solely dedicated to selling fine art. *See* Wilcox Trial Brief at 6, 7, 9, 12-13. Wilcox seems to believe that this is the only circumstance under which a likelihood of confusion can be found. Such a narrow view is incorrect. *See Hilson Research*, 27 U.S.P.Q.2d at 1432-39. First, Wilcox ignores the strength and fame of the RITZ Marks that extends even to unrelated goods and services. *See NASDAQ*, 69 U.S.P.Q.2d at 1734. Additionally, Wilcox ignores the extensive evidence that Ritz-Carlton uses its marks in connection with art gallery services and a wide variety of art-related services. Ritz-Carlton need not operate a stand-alone art gallery in a “gallery setting” that sells fine art exclusively in order to be deemed to be using its marks in connection with the advertising, promotion, and sale of art gallery services. In essence, RITZ-CARLTON hotels are art galleries. *See* Ritz-Carlton Trial Brief at 17-19. Fine art is sold at RITZ-CARLTON properties by Ritz-Carlton and others, including art featured on the hotel walls

⁸ Not only restrooms, as Wilcox’s brief would lead the Board to believe. *See* Wilcox Trial Brief at 9.

⁹ Wilcox takes issue with the un rebutted testimony of a Ritz-Carlton witness who testified that Ritz-Carlton takes the approach of “everything is for sale” in its hotels, including the artwork featured in the rooms. *See* Wilcox Trial Brief at 9. Wilcox’s sole effort to rebut this sworn testimony is to say that Mr. Flint’s statement is an “obviously absurd assertion.” *Id.* Wilcox has no support for this statement, never questioned Ritz-Carlton’s witness on this issue, and has no reason to disbelieve this sworn testimony of a longstanding Ritz-Carlton employee. *See* Flint Dep. at 124-125.

and in gift shops, and Ritz-Carlton uses the RITZ Marks to promote the services Ritz-Carlton offers at those properties.

Wilcox's view of what constitutes art gallery services is too limiting. For example, restaurants located within Ritz-Carlton's properties operate under different marks, yet there is no question that Ritz-Carlton uses its RITZ Marks in connection with the advertising, promotion, and sale of restaurant services. Similarly, because of the well-documented activities in which Ritz-Carlton is involved relating to art, including the sale of fine art, there can be no doubt that Ritz-Carlton uses marks containing RITZ in connection with advertising, promotion, and sale of art gallery services. Indeed, Ritz-Carlton is not the only company to offer both hotel services and art gallery services. Ritz-Carlton has submitted documentary evidence showing the presence of art galleries in other hotels and the use of art to enhance hotel sales. *See* Notice of Reliance Ex. 35. This demonstrates "that the listed goods and/or services are of a type which may emanate from a single source." *In re Albert Trostel & Sons Co.*, 29 U.S.P.Q.2d 1783, 1786 (TTAB 1993). Accordingly, consumers would expect that hotel companies would offer art gallery services.

Wilcox also claims that there can be no confusion because the registrations for the RITZ Marks on which Ritz-Carlton is relying make "no mention of art gallery services in International Class 035" and that "the usage of the mark, RITZ alone, for art gallery services in IC 035 has not been registered to date." *See* Wilcox Trial Brief at 15. This argument ignores the fact that Ritz-Carlton is relying in part on common law rights created through use, ignores the fact that likelihood of confusion can be found between marks used on goods or services falling in different classes, ignores the fame of the RITZ Marks, and ignores the remainder of the DuPont factors.

Consequently, the similarity of the services in this case weighs in favor of Ritz-Carlton and mandates a finding of likelihood of confusion.

4. Confusion Is Likely Because The Channels Of Trade Are The Same.

Wilcox argues that “there are no similar channels of trade, except for the Internet.” *See* Wilcox Trial Brief at 16. This is untrue and unsupported. Wilcox’s application contains no limitation on the channels of trade. In the absence of specific limitations in the opposed application, likelihood of confusion must be analyzed in light of normal and usual channels of trade and methods of distribution for the services at issue. *Octocom Systems, Inc. v. Houston Computer Services, Inc.*, 16 U.S.P.Q.2d 1783, 1787 (Fed. Cir. 1990) (registrability must be decided on the basis of the identification of the goods set forth in the application, not on alleged actual channels of trade or classes of purchasers) [hereinafter *Octocom Systems*]; *see CBS, Inc. v. Morrow*, 218 U.S.P.Q. 198, 199 (Fed. Cir. 1983) (noting that “[t]he description of the goods in an application for registration is critical because any registration that issues will carry that description” and that a registrant could change its business practices anytime). It must be presumed that the services move through all the ordinary and normal channels of trade for such goods to all the usual purchasers for such products. *Schieffelin & Co., v. Molson Cos. Ltd.*, 9 U.S.P.Q.2d 2069, 2073 (TTAB 1989). As explained by the Federal Circuit:

The issue in an opposition is the right of an applicant to register the mark depicted in the application for the goods identified therein. The authority is legion that the question of registrability of an applicant’s mark must be decided on the basis of the identification of goods set forth in the application regardless of what the record may reveal as to the particular nature of an applicant’s goods, the particular channels of trade or the class of purchasers to which sales of the goods are directed.

* * *

An application with an identification of goods having no restriction on trade channels obviously is not narrowed by testimony that the applicant’s use is, in fact, restricted to a particular class of purchasers . . . Thus, such

evidence does not support OSI's alleged right to registration of the mark for the goods set forth in the application at issue.

Octocom Systems., 16 U.S.P.Q. 2d at 1787 (citations omitted).

The Board should assume that Wilcox will sell his services in all channels covered by the description in his application: "Art galleries offering original and limited edition fine art, namely, paintings, photographs, sculptures and prints." Wilcox does not contest that art gallery services are advertised in magazines, newspapers, direct mailings, the Internet, and through hotel personnel – the same channels where Ritz-Carlton's goods and services are advertised and sold. *See* Ritz-Carlton Trial Brief at II.E, I.F, and 23-24. Moreover, despite Wilcox's assertions to the contrary, Ritz-Carlton has submitted un rebutted evidence that other hotels feature art galleries and that art is regularly associated with hotels and the hotel industry and is used to enhance sales. *See* Notice of Reliance Ex. 35. Indeed, Wilcox has admitted that there is an overlap in the channels of trade. *See* Notice of Reliance Ex. 17 at answer to Request for Admission No. 11. As the services at issue are offered and sold through the same channels of trade, the likelihood of confusion is greatly enhanced.

5. Likelihood Of Confusion Is Enhanced Because Wilcox Has Offered No Evidence Of Third Party Use Or Registration Of RITZ.

Wilcox's unsupported statements as to third parties who allegedly use and have registered RITZ marks are irrelevant and inadmissible. *See* Evidentiary Objections Section II.A and II.B. There is no evidence of record that *any* third party uses or has registered RITZ for any goods or services.

6. Confusion Is Likely Because Both Parties Sell To The Same Purchasers.

Both parties' goods and services are targeted to the same customers. This greatly enhances the likelihood of consumer confusion. Wilcox attempts to sidestep this evidence by arguing that purchasers of his services will have a high level of sophistication and take a great degree of care in purchasing art. *See* Wilcox Trial Brief at 17. However, Wilcox's allegations pertaining to this factor are completely unconnected to any facts of record. Fine art, including prints and photographs, need not be "expensive" and cost "tens of thousands of dollars," as Wilcox asserts. *See* Wilcox Trial Brief at 7, 16. Indeed, Ritz-Carlton has submitted testimony that it sells art such as prints and posters for a few dollars. *See* Flint Dep. at 35-36; Gajcak Dep. at 61. Moreover, because there is no limitation in the description of Wilcox's services, it must be assumed that the services are sold in all channels of trade to all relevant consumers. Thus, if Wilcox opens an art gallery under the mark RITZ, it must be presumed that he will sell to the same customers who buy art from the walls of art galleries in RITZ-CARLTON hotels.

Furthermore, even if some customers were found to be sophisticated, there would still be a likelihood of confusion in view of the other factors that favor Ritz-Carlton. For example, in *Grotrian, Elfferich, Shultz, Th. Steinweg Nachf. v. Steinway & Sons*, 523 F.2d 1331, 1341 (2d Cir. 1975), evidence that the products at issue were expensive pianos, and that prospective customers were educated and sophisticated, did not eliminate the likelihood of confusion between the marks STEINWAY and GROTRIAN-STEIWEG for pianos. Similarly, in *AMF, Inc. v. Sleekcraft Boats*, 599 F.2d 341, 353-54 (9th Cir. 1979), the court held that defendant's use of the mark SLEEKRAFT for its line of high-speed, sporty recreational boats created a likelihood of confusion with plaintiff's registered mark SLICKRAFT, even though the products at issue were very expensive and bought only after careful consideration. The court observed

that a higher level of care would not eliminate the risk that consumers would associate the sources of the products. *See id.* The same reasoning may be applied here.

In view of all of these considerations, it is evident that the types of purchasers to whom the parties are likely to sell their goods and services enhances the likelihood of confusion. This factor weighs in favor of Ritz-Carlton.

7. The Absence Of Actual Confusion Evidence Is Irrelevant, As Wilcox Has Not Yet Used His Mark.

Wilcox claims there is no actual confusion evidence in this case. *See* Wilcox Trial Brief at 21. Of course, as Ritz-Carlton stated in its Trial Brief, this is not surprising because Wilcox has not yet commenced use of RITZ. As such, the lack of actual confusion evidence is wholly irrelevant. *See Weiss Assocs., Inc. v. HRL Assocs., Inc.*, 14 U.S.P.Q.2d 1840, 1843 (Fed. Cir. 1990).

8. The Extent Of Potential Confusion Is Substantial.

Given the extraordinary fame of the RITZ Marks and the fact that Wilcox seeks to register an identical or nearly identical mark for the same or related services offered to the same prospective customers in the same trade channels, the potential for confusion is substantial. Wilcox cites to the fact that the Trademark Examiner approved his mark for publication without citing to any pending or registered marks. *See* Wilcox Brief at 5, 21. If Trademark Examiners were the sole arbiters for determining whether a likelihood of confusion exists, there would be no need for opposition proceedings. Trademark Examiners do not have a full record of facts and are not able to take into account the fame of a potentially conflicting registered mark in determining whether to bar registration, nor do they consider common law use of the type Ritz-Carlton has provided in this case. Given the extraordinary documented fame of the RITZ Marks and Ritz-

Carlton's use in connection with the sale of fine art and other art-related services, there is a great potential for confusion.

* * *

For the foregoing reasons, Wilcox's mark should be refused registration on the grounds of likelihood of confusion with Ritz-Carlton's RITZ Marks.

B. THE OPPOSITION SHOULD BE SUSTAINED BECAUSE WILCOX'S MARK CREATES A FALSE SUGGESTION OF ASSOCIATION

Wilcox's only response to Ritz-Carlton's claim of false suggestion of association is that "it is unlikely that consumer (sic) will falsely associate Applicant and Opposer." *See* Wilcox Trial Brief at 17. In support, Wilcox cites to *Recot*, 54 U.S.P.Q.2d at 1894 as holding that "opposer's Section 2(a) false suggestion of a connection: ground of opposition fails for lack of proof." *See* Wilcox Trial Brief at 17. However, the *Recot* court made no such holding. In *Recot*, the Federal Circuit reversed the dismissal of an opposition, on the grounds that the Board improperly discounted the fame of the opposer's marks. *Recot*, 54 U.S.P.Q.2d at 1900. In short, this case does not stand for the proposition that Wilcox claims it does.

On the other hand, Ritz-Carlton has provided overwhelming evidence of the extraordinary fame and public recognition of the RITZ Marks. *See* Ritz-Carlton Trial Brief at 16-18. Ritz-Carlton has provided evidence of the fourteen registrations for the RITZ Marks that were properly entered into evidence by Ritz-Carlton. Ritz-Carlton's evidence clearly establishes that the relevant consuming public associates the RITZ Marks with Ritz-Carlton. Even Wilcox has conceded that Ritz-Carlton's marks are famous. *See* Wilcox Trial Brief at 12. Because the parties' marks are identical or virtually identical, customers will mistakenly assume that Wilcox is connected with Ritz-Carlton. Furthermore, even though Wilcox was aware of Ritz-Carlton's

famous RITZ Marks prior to adoption if his mark, intent to trade upon the goodwill of the senior user is not required to find false suggestion under Section 2(a). *See Consolidated Natural Gas v. CNG Fuel Systems, Ltd.*, 228 U.S.P.Q. 753, 754 (TTAB 1985). Consequently, Wilcox's mark falsely suggests a connection with Ritz-Carlton, and registration should be refused.

C. WILCOX'S USE OF RITZ IS LIKELY TO DILUTE RITZ-CARLTON'S FAMOUS RITZ MARKS

1. Ritz-Carlton's RITZ Marks Are Famous.

In addition to being famous for purposes of likelihood of confusion, Ritz-Carlton's RITZ Marks are famous within the meaning of the Federal Trademark Dilution Act. *See* 15 U.S.C. § 1125(c). The Board has previously held that evidence of widespread recognition of a mark is required to qualify for dilution fame. *See Nasdaq*, 69 U.S.P.Q.2d at 1736. Under this standard, Ritz-Carlton's RITZ Marks, and in particular the mark RITZ-CARLTON, unquestionably qualify for dilution fame.

As a result of more than eighty years of use, advertising, and promotion of the RITZ and RITZ-CARLTON marks, and many years of use of the other RITZ Marks, there is widespread recognition of these marks. The fame of the RITZ Marks is also demonstrated by the substantial advertising and marketing of the RITZ Marks throughout the United States, which amounts to millions of dollars each year and has resulted in substantial annual sales in the billions of dollars. *See* Ritz-Carlton Trial Brief at 8-12. The RITZ Marks are also the subject of a number of federal registrations, including the fourteen upon which Ritz-Carlton is relying in this proceeding. *See* Notice of Reliance, Exs. 5-15. Thus, the RITZ Marks are famous marks within the meaning of the Federal Trademark Dilution Act.

2. The RITZ Marks Are Distinctive.

Notwithstanding Wilcox's unsupported statements to the contrary, Ritz-Carlton's RITZ Marks are inherently distinctive. No showing of secondary meaning was ever required to register the RITZ Marks. These marks are registered and used with a wide variety of good and services. *See* Ritz-Carlton Trial Brief at 3-8. They are also well recognized and famous in the United States and are commercially strong. *See id.* at 8-12. Wilcox has offered no evidence to rebut these facts or show that the RITZ Marks are descriptive or generic.

3. Any Use By Wilcox Of RITZ Will Commence Long After Ritz-Carlton's RITZ Marks Became Famous.

Ritz-Carlton has been using marks containing RITZ for over eighty years, and these marks have long been famous as a result of extensive use, advertising, and promotion. Wilcox filed its application in 2003 based on an intent to use and has admittedly made no use of the mark. There can be no dispute that any use of RITZ by Wilcox will commence well after the fame of the RITZ Marks was well-established.

4. Registration Of RITZ Will Dilute Or Is Likely To Dilute Ritz-Carlton's Famous RITZ Marks.

Dilution by "blurring occurs when a substantial percentage of consumers, upon seeing the junior party's use of a mark on its goods, are immediately reminded of the famous mark and associate the junior party's use with the owner of the famous mark, even if they do not believe that the goods come from the famous mark's owner." *Toro Co. v. ToroHead, Inc.*, 61 U.S.P.Q.2d 1164, 1183 (TTAB 2001). Under the six-factor likelihood of dilution test, there is no question that registration of Wilcox's RITZ mark is likely to cause dilution of the famous RITZ Marks. As stated earlier, the RITZ mark is identical to Ritz-Carlton's RITZ mark and virtually identical to Ritz-Carlton's other RITZ Marks. In addition, the RITZ Marks are distinctive,

arbitrary, and famous, and Ritz-Carlton is one of the most famous companies in the world. Ritz-Carlton has policed and protected its RITZ Marks, which have been in substantially exclusive use by Ritz-Carlton in connection with its goods and services. Wilcox was aware of Ritz-Carlton's rights in the RITZ Marks before adopting RITZ as his own mark. Finally, because of the wide variety of goods and services offered by Ritz-Carlton that feature the RITZ Marks, a substantial number of customers who encounter use of RITZ by Wilcox will either conclude that it was Ritz-Carlton's mark being used on or in connection with these products, or "would have to reach a contrary conclusion only by associating the mark less strongly" with Ritz-Carlton. *See NASDAQ Stock Market*, 69 U.S.P.Q.2d at 1737. "Either result would be a blurring and would lessen the capacity" of Ritz-Carlton's marks to identify its goods and services. *Id.*

Accordingly, registration of RITZ is likely to dilute Ritz-Carlton's famous RITZ Marks, and Wilcox's mark should be denied registration.

IV. CONCLUSION

For all the foregoing reasons and those discussed in Ritz-Carlton's Trial Brief, this opposition should be sustained, and registration of Wilcox's mark should be denied.

Respectfully submitted,

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CERTIFICATE OF SERVICE

It is hereby certified that a copy of the attached is being served upon Applicant's counsel Richard D. Clarke at 3755 Avocado Boulevard, La Mesa, California 91941 by first class mail, postage prepaid, on August 6, 2007.


